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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/893,547 | 06/29/2001 | Jonathan Sharp | 367.40282X00 | 4444 |
| 20457 | 7590 | 11/16/2004 | EXAMINER | |
| ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-9889 | | | PARTON, KEVIN S | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2153 | |

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/893,547

Applicant(s)

SHARP ET AL.

Examiner

Kevin Parton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No: ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) *
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/29, 3/19, 11/3.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The abstract of the disclosure is objected to because the phrase "This invention relates to" is unnecessary. Correction is required. See MPEP § 608.01(b).
3. Claim 5 is objected to because of the following informalities: it has two commas following the word "content" in line 8. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite because it recites the limitations "first party" and "second party" in line 10. There is insufficient antecedent basis for this limitation in the claim.
6. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. The

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phrase "described with reference to accompanying drawings" does not adequately describe the claim limitations.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Fette et al. (USPN 6,052,600).

9. Regarding claim 1, Fette et al. (USPN 6,052,600) teach a system for downloading content from a server to a mobile phone, comprising: a content provider providing original content for storage on and use by the mobile phone (column 3, lines 43-45; figure 1, element 114), a content provider providing adaptation data for adapting the original content stored on a mobile phone (column 4, lines 26-29), making the adaptation data available for downloading onto the mobile phone from the server (column 4, lines 34-35), monitoring the downloading of the adaptation data from the server and computing a payment to be made to the content provider (column 3, lines 61-63), whereby the content provider is remunerated for the original content and the adaptation data substantially by the computed payments (column 4, lines 37-39).

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10. Regarding claim 2, Fette et al. (USPN 6,052,600) teach a system for downloading content from a server to a mobile phone wherein content is provided for storage on and use by the mobile phone by a content provider (column 3, lines 43-45; figure 1, element 114; column 2, lines 62-63), and adaptation data for adapting the original content stored on a mobile phone is provided by the content provider (column 4, lines 26-29), and is made available for downloading onto the mobile phone from a server (column 4, lines 34-35), wherein monitoring and accounting means monitor the downloading of the adaptation data from the server for computing a payment to be made to the content provider (column 3, lines 61-63), wherein the content provider is remunerated for the original content and the adaptation data substantially by the computed payments (column 4, lines 37-39).

11. Regarding claim 3, Fette et al. (USPN 6,052,600) teach a system wherein:

- a. A first party provides content for a handheld electronic device having a transceiver (column 3, lines 43-45; figure 1, element 114; column 2, lines 62-63).
- b. A second party receives the content from the first party and makes the content available for downloading from a server (column 4, lines 34-35).
- c. The arrangement being such that the second party makes payment to the first party in accordance with the occurrences of the content being downloaded from the server (column 4, lines 37-39).

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12. Regarding claim 4, Fette et al. (USPN 6,052,600) teach all the limitations as applied to claim 3. They further teach means wherein a third party downloads the content from the server, and the downloading is registered in a monitoring means associated with the server (column 4, lines 25-40).

13. Regarding claim 5, Fette et al. (USPN 6,052,600) teach a system for downloading content onto a handheld electronic device having a transceiver comprising:

- a. A server for storing the content and for making the content available for downloading therefrom, the content being made available to a first party by a second party (column 4, lines 25-35; figure 1, element 110).
- b. Monitoring means for monitoring the downloading of the content from the server to provide at least one parameter indicative of the number of downloads of the content (column 3, lines 61-63).
- c. Accounting means for computing responsive to the at least one parameter, a payment to be made whereby the first party remunerates the second party (column 4, lines 37-40).

14. Regarding claim 6, Fette et al. (USPN 6,052,600) teach a system comprising:

- a. A content enabler obtaining content from a content provider and storing the content on a server (column 4, lines 34-35; figure 1, element 110).
- b. The content enabler responsive to downloads of the content from the server issuing a payment to the content provider (column 4, lines 37-40).

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15. Regarding claim 7, Fette et al. (USPN 6,052,600) teach a system for downloading content onto a handheld electronic device having a transceiver comprising:

- a. Storage means for storing content (figure 1, element 110).
- b. Control means for downloading content from the server (column 4, lines 34-35).
- c. Monitoring means for monitoring the level of downloads of the content from the server (column 3, lines 61-63).
- d. Processing means for computing a payment to be made in dependence on the monitored level of downloads (column 4, lines 37-40).

16. Regarding claim 8, Fette et al. (USPN 6,052,600) teach all the limitations as applied to claim 7. They further teach means wherein the processing means computes a payment comprising an aggregate figure of the number of downloads of the content (column 3, lines 61-63; column 4, lines 37-40).

17. Regarding claim 9, Fette et al. (USPN 6,052,600) teach a system for downloading content comprising:

- a. A first party providing mobile phone content upgrade (figure 1, element 114).
- b. A second party obtaining the content upgrade from the first party and providing the content upgrade for downloading onto a mobile phone and making a payment to the first party independence upon the

volume of downloads of the content upgrade (column 3, lines 61-63;
column 4, lines 26-40).

18. Regarding claim 10, Fette et al. (USPN 6,052,600) teach a client-server system in which:

- a. Content is provided by a first party (column 4, lines 26-27, figure 1, element 114).
- b. The content is stored on the server by a second party so as to make it retrievable from the server by a client (column 4, lines 34-35).
- c. The second party remunerates the first party in dependence on the number of times the content is downloaded by a client (column 3, lines 61-63; column 4, lines 37-40).

19. Regarding claim 11, Fette et al. (USPN 6,052,600) teach a handheld electronic device having a transceiver and adapted to download content from a server, the device having a memory, and a controller, the memory storing original and/or adapted content provided by a content provider (column 4, lines 34-36), the controller being operable to transmit a request for adaptation data (column 4, lines 30-32), the request comprising an identifier of the original and/or adapted content, the transceiver receiving the adaptation data from a server, and the controller storing the data on the memory (column 4, lines 30-36), the transceiver in response to said storing of the adaptation data transmitting an acceptance signal whereby a payment is computed to be made to the content provider and whereby the content provider is remunerated for the original

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content and the adaptation data substantially by the computed payments (column 3, lines 61-63; column 4, lines 37-40).

20. Regarding claim 12, Fette et al. (USPN 6,052,600) teach a system for downloading content onto a handheld electronic device having a transceiver comprising:

- a. A server for storing the adaptation data and for making the adaptation data available for downloading therefrom, the content being made available to a content enabler by a content provider (column 4, lines 25-35; figure 1, element 110).
- b. Monitoring means for monitoring the downloading of the adaptation data from the server to provide at least one parameter indicative of the number of downloads of the adaptation data (column 3, lines 61-63).
- c. Accounting means for computing responsive to the at least one parameter, a payment to be made whereby the first party remunerates the second party (column 4, lines 37-40).

21. Regarding claim 13, Fette et al. (USPN 6,052,600) teach all the limitations as applied to claim 12. They further teach means wherein the content enabler embeds original content on the device, and the content provider produces further new adaptation data (column 3, lines 38-42; column 4, lines 25-29).

Conclusion

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please see the following:

- a. Fawcett et al. (USPN 6,327,617)

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b. Brunemann et al. (USPN 6,487,717)

c. Zellner et al. (USPN 6,807,564)


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Parton whose telephone number is (703)306-0543. The examiner can normally be reached on M-F 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (703)305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kevin Parton
Examiner
Art Unit 2153

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